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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/568,341	02/14/2006	Masahiko Kubota	03500.518807.	3333
5514 7590 06/19/2009 FITZPATRICK CELLA HARPER & SCINTO 30 ROCKEFELLER PLAZA NEW YORK, NY 10112				
EXAMINER				
RAYMOND, BRITTANY L				
ART UNIT		PAPER NUMBER		
1795				
MAIL DATE		DELIVERY MODE		
06/19/2009		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/568,341

**Applicant(s)**

KUBOTA ET AL.

**Examiner**

BRITTANY RAYMOND

**Art Unit**

1795

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 2/14/2006; 5/17/2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-24 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 14 February 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-8508)  
Paper No(s)/Mail Date See Continuation Sheet
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

Continuation of Attachment(s) 3). Information Disclosure Statement(s) (PTO/SB/08), Paper No(s)/Mail Date :2/14/2006; 5/17/2007; 5/17/2007; 6/19/2007; 4/16/2008.

## **DETAILED ACTION**

### ***Claim Objections***

1. Claims 4-7 objected to because of the following informalities: The word, "path," is spelled incorrectly. Appropriate correction is required.

### ***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 1-24 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Throughout the claims, there are antecedent basis problems because the word, "the," is used instead of "a" or "an." For example, claim 4 recites "a step of forming an ionizing radiation decomposing type positing type resist layer including a methyl isopropenyl ketone as **the** first positive type photosensitive material layer to be sensitized by an ionizing radiation beam of **the** first wavelength range" (lines 8-11). The words, "the" should be changed to "a" in this example.

### ***Double Patenting***

4. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir.

1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

5. Claims 1-24 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-6, 9 and 10 of U.S. Patent No. 6951380. Although the conflicting claims are not identical, they are not patentably distinct from each other because both inventions teach forming a first positive resist of a first material and sensitive to a first radiation on a substrate, forming a second positive resist of a second material and sensitive to a second radiation on the first resist, exposing the second resist to a second radiation, developing the second resist, exposing the first resist to a first radiation, and developing the first resist to form a mold pattern. Both inventions also teach forming a resin over the mold pattern, and removing the mold pattern to form a liquid discharge head. Although the materials of the first and second resists are flipped in the two inventions, the process could easily be carried out by reversing the materials of the first and second resist by reversing the wavelength of light used for the first and second exposures.

***Claim Rejections - 35 USC § 102***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 1-24 are rejected under 35 U.S.C. 102(b) as being anticipated by Kubota (U.S. Patent Publication 2004/0070643).

Regarding claims 1, 2 and 4-7, Kubota discloses a process of forming a structure comprising: coating a substrate with a first positive resist layer, baking the first positive resist layer, coating the first positive resist layer with a second positive resist layer comprising polymethyl isopropenyl ketone, baking the second positive resist layer, exposing the second resist to a second wavelength of light, developing the second resist, exposing the first resist to a first wavelength of light, and developing the first resist to form a convex pattern on the substrate (Paragraphs 0058-0063 and Figures 1A-1F). The process could easily be carried out by reversing the materials of the first and second resist by reversing the wavelength of light used for the first and second exposures. Kubota also discloses that the first resist layer can comprise a methacrylic copolymer composite including methacrylic acid, which has 2 to 30% methacrylic acid and a molecular weight of 5,000-50,000 (Paragraph 0053). It is inherent that an anhydride is formed by simply removing water from a chemical compound, often an acid.

As to claims 4-7, Kubota teaches that after patterning the first and second resist layers, the patterned resists act as a mold, a resin is coated over the mold material, and then the mold material is dissolved and removed to form an ink channel (Paragraph 0050).

Regarding claims 6 and 7, Kubota teaches that after the resin is formed over the patterned resist layers, ink channels are exposed into the resin, the substrate is irradiated to ionizing radiation to decompose the resist patterns, and the resist patterns are removed using a solvent (Paragraphs 0071-0075 and Figures 2A-2D).

As to claims 3, 8 and 12-15, Kubota discloses that the first and second resists are baked after applying them to the substrate in order to remove coating solvents and crosslink the layers (Paragraphs 0058-0059).

Regarding claims 9 and 16-18, Kubota teaches that the polymethyl isopropenyl ketone resist layer is sensitive to light with a wavelength in the range of 260 nm to 330 nm and that the methacrylic copolymer resist layer is sensitive to light with a wavelength in the range of 210 nm to 330 nm (Paragraph 0051).

As to claims 10, 19, 21 and 23, it is apparent from the Figures of Kubota that the height of the liquid flow path is provided relatively lower at a point adjacent to the bubble generating chamber on the liquid discharge energy generating element.

Regarding claims 11, 20, 22 and 24, it is apparent from the Figures of Kubota that the bubble generating chamber on the liquid discharge energy generating element is a convex shape.

Kubota teaches every limitation of claims 1-24 of the present invention and thus anticipates the claims.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to BRITTANY RAYMOND whose telephone number is

(571)272-6545. The examiner can normally be reached on Monday through Friday, 8:30 a.m. - 5:00 p.m. EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark Huff can be reached on 571-272-1385. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

**/Kathleen Duda/  
Primary Examiner, Art Unit 1795**

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